

REMARKS

The two telephone interviews (of which the first was initiated by the Examiner) kindly granted to applicants' undersigned attorney are hereby gratefully acknowledged.

During the interviews, the claims, the prosecution history, the reference applied in rejecting the claims (Chta et al. '560) and the previously filed Declaration under 37 C.F.R. §1.132 were discussed. In the second of the telephone interviews, the undersigned attorney advised the Examiner of certain additional information (received from the applicants following the first telephone interview), proposed an amendment of claim 11, and undertook to submit a Supplemental Amendment (setting forth the proposed amendment of claim 11) and a Supplemental Declaration under §1.132 (including the aforementioned additional information). No agreement was reached as to the claims.

Attached hereto is a copy (received, via Facsimile transmission, by applicants' undersigned attorney) of an executed Supplemental Declaration under 37 C.F.R. §1.132, setting forth the aforementioned additional information.

By the present Supplemental Amendment, claim 11 has been amended as proposed during the telephone interviews, to recite

"said emulsion having a continuous oil phase and a discontinuous water phase and said resin being present in said continuous phase and not in said discontinuous phase."

This recital is supported by the disclosure of the original application, e.g. at page 18, lines 6-12, in the specification; in Example 1 at pages 30-31; in Example 4 at pages 32-33; and in original claim 12, which recites that "a non-solvent with respect

to said resin is added dropwise to said resin solution with stirring to prepare said water-in-oil emulsion of said resin." Also, at page 12, lines 3-6, in the specification, it is explained that the "pores are formed [in the porous resin layer] as the water droplets contained in the coated porous resin layer formation coating liquid are evaporated."

The attached Supplemental Declaration explains, in particular, that

- (1) the reason the layer formed in Experiment (2) of the previous Declaration under S1.132 was not porous was that the resin was present in the internal, discontinuous (water) phase rather than the external, continuous (oil) phase;
- (2) in the present invention, it is necessary that the resin be in the continuous (oil) phase, not in the discontinuous (water) phase; and
- (3) if a silicone mold release agent were added as a stick-preventing agent to the porous resin layer formation coating liquid in accordance with Ohta et al. '560, it would be present as an oil-in-water emulsion, not as a water-in-oil emulsion.

The Declarant is a joint applicant in the present application and is also a joint inventor of Ohta et al. '560.

The only outstanding substantive issue in this case is whether independent claim 11, and certain of the claims dependent thereon, are anticipated by Ohta et al. '560. If the claims are not anticipated, it is immaterial whether their subject matter would have been obvious from Ohta et al. '560 under 35 U.S.C. §103(a), in view of the Statement of Common Ownership heretofore submitted (in the response filed July 6, 2004).

Ohta et al. '560 does not teach any method of forming a porous resin layer using a porous resin layer formation coating liquid comprising a water-in-oil emulsion of a resin, wherein the

emulsion has a continuous oil phase and a discontinuous water phase and the resin is present in the continuous phase and not in the discontinuous phase.

That is to say, even assuming arguendo that (as asserted in previous Office Actions) Ohta et al. '560 (see col. 4, lines 16-17 and 49-51) could be said to teach the inclusion of a silicone mold release agent in a porous resin layer formation coating liquid so as to constitute a water-in-oil emulsion, there is no teaching that the resin would be present in a continuous oil phase of such an emulsion.

Experiment (2) described in the previously submitted Declaration under §1.132 shows that when the resin is present in the discontinuous (water) phase rather than in the continuous (oil) phase of a water-in-oil emulsion, the oil being a silicone oil, a porous layer is in fact not formed.

Moreover, in the attached Supplemental Declaration, the Declarant (who is a joint inventor in Ohta et al. '560) declares that "If the silicone mold release agent referred to in Ohta et al. '560 at col. 4, lines 49-51, were added to the resin layer formation coating liquid therein to serve as a stick-preventing agent in accordance with the description in Ohta et al. '560 at col. 4, lines 16-17, so as to form an emulsion, the obtained emulsion would be an oil-in-water emulsion wherein the silicone oil is dispersed in the water phase, not a water-in-oil emulsion."

Since Ohta et al. '560 does not teach any method employing a porous resin layer formation coating liquid comprising a water-in-oil emulsion of a resin, wherein the emulsion has a continuous oil phase and a discontinuous water phase and the resin is present in the continuous phase and not in the discontinuous phase, as recited in herein-amended claim 11, it is submitted that neither amended claim 11 nor any of claims 12 - 21 dependent thereon is anticipated by Ohta et al. '560. It follows that all of previ-

ously rejected claims 11, 14, 16, 17, 19 and 20 are allowable, and that the objection to claims 12 and 18 (for dependence on a rejected claim) is overcome. Furthermore, in view of the allowability of generic independent claim 11, it is respectfully requested that withdrawn dependent species claims 13, 15 and 21 be examined on the merits and allowed as well.

For the foregoing reasons, it is believed that this application is now in condition for allowance. Favorable action thereon is accordingly courteously requested.

Respectfully,

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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

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Reg. No. 22,031 Date NOVEMBER 8, 2004